



Paper NO. 5

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In re Application of :
Amir Weinberg and Eran Leshem : DECISION REFUSING STATUS
Application No. 09/315,795 : UNDER 37 CFR 1.47(a)
Filed: May 21, 1999 :
Attorney Docket No. MERCURY.1CP1C1 :

This is in response to the petition under 37 CFR §1.47(a), filed November 8, 1999.

The above-identified application was filed as a continuation of prior application 08/949,680, on May 21, 1999 without an executed oath or declaration and naming Amir Weinberg and Eran Leshem as joint inventors.

Accordingly, on June 23, 1999, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration, and a surcharge for late filing.

In response, on November 8, 1999, a copy of the declaration from prior application 08/949,680 signed by Amir Weinberg and Eduardo Alperin; a new declaration indicating Amir Weinberg and Eran Leshem as joint-inventors and signed by Eran Leshem; a communication and Petition under 37 CFR §1.47(a) with petition fee; the required surcharge for filing a late declaration and a three (3) month extension of time were filed.

Petitioner contends that a new oath or declaration signed by both of the named inventors is not required because the signature of one of the named inventors may be found on the declaration filed in prior application 08/949,680.

37 CFR §1.63(d)(1) states:

A newly executed oath or declaration is not required under §1.51(b)(2) and §1.53(f) in a continuation or divisional application, provided that:

(i) The prior nonprovisional application contained an oath or declaration as prescribed by paragraphs (a) through (c) of this section;

(ii) The continuation or divisional application was filed by all or by fewer than all of the inventors named in the prior application;

(iii) The specification and drawings filed in the continuation or divisional application contain no matter that would have been new matter in the prior application; and

(iv) A copy of the executed oath or declaration filed in the prior application, showing the signature or an indication thereon that it was signed, is submitted for the continuation or divisional application.

However, 37 CFR §1.63(d)(5) states:

A newly executed oath or declaration must be filed in a continuation or divisional application naming an inventor NOT named in the prior application. (Emphasis added)

Accordingly, the copy of the declaration from prior application 08/949,680 is NOT acceptable because it does not contain all of the named inventors in the continuation application filed May 21, 1999. Eran Leshem was not listed as an inventor on the declaration of prior application 08/949,680. Applicant must file a new declaration signed by inventors Amir Weinberg and Eran Leshem.

Petitioners have requested that this situation be treated as a petition under 37 CFR §1.47(a) if the declaration from prior application 08/949,680 was unacceptable.

The petition under 37 CFR §1.47(a) is **dismissed**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION. Any extensions of time will be governed by 37 CFR 1.136(a).

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and
- (4) a statement of the last known address of the non-signing inventor.

Applicant lacks items (1), as set forth above.

As to item (1), petitioner appears to demonstrate that Mr. Weinberg was only presented with the Declaration. Petitioner states, "the undersigned [attorney of record] sent the Declaration and a cover letter to Mr. Weinberg's residence ... on July 28, 1999." Petition, pg. 2. However, 37 CFR § 1.47(a) requires an attempt be made to present the non-signing inventor with the application papers, including the specification, claims and drawings. As indicated on page 2 of the petition, an attempt to present Mr. Weinberg with the application papers, including the specification, claims and drawings, has not been made.

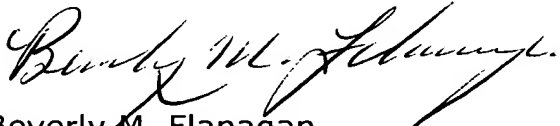
Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
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Telephone inquiries related to this decision should be directed to Petitions Attorney Edward Tannouse at (703) 306-9200.



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